

**Office Action Summary**

Application No.

10/037,377

Applicant(s)

SIGL, WAYNE CLEMENT

Examiner

Karin M. Reichle

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 4,12,18 and 26-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13-17 and 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 38-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 5.

2. Claims 4, 12, 18, 26-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

3. Applicant's election with traverse of the species of Figures 3-4 and Figures 5-8 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that a common search is necessary for all the species. This is not found persuasive because not only is a common search not necessarily required but the consideration of the prior art with respect to elected claims 1-3, 5-11, 13-17 and 19-25 would not necessarily include consideration of the same claimed features as those set forth in the nonelected claims 4, 12, 18 and 26-37. Claims 4, 12, 18 and 26 are also withdrawn in addition to claims 27-37 because the Figures of the elected species do not show such features. Also although Applicants did not specifically elect a shape as required in paper No. 5, it is assumed the elected shape is that shown in the elected species of Figures 3-4 and 5-8.

The requirement is still deemed proper and is therefore made FINAL.

***Information Disclosure Statement***

4. The information disclosure statement filed 12-31-01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

***Specification***

***Description***

5. The abstract of the disclosure is objected to because the legal terminology, i.e. "comprise", should be avoided. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: On page 10, line 3, after "x-axis", insert --X-X--. On page 10, line 8, after "y-axis", insert --Y-Y--. On page 10, line 10, after "z-axis", insert --Z-Z--. On page 10, line 11, change "upwardly" to --"upwardly"--. On page 13, line 6, should "nits" be --knits--? On page 20, lines 21-22, Applicants refer to a description located previously, where is this description? On page 21, line 3, after "section", -- 94 or-- should be inserted. On page 23, lines 5-6, "DISPOSE OF PROPERLY" should be -- "DISPOSE OF PROPERLY"--. On page 4, line 26, should "40" be --50--? See claims 6 and 20.

Appropriate correction is required.

***Claim Objections***

7. Claims 1-3, 5-11, 13-17 and 19-25 are objected to because of the following informalities: in claim 1, line 7, "the" should be --a--. On line 9, "facing"(all) should be --faceable--. In claims 2-3, 5-11 and 13, line 1, "An" should be --The--. In claim 2, last line, after "article", --- should be inserted. In claims 5-7 and 11, "facing"(all) should be --faceable--. In claim 6, lines 1-2, ",", and up to" should be --to no more than-- and on line 2, ",", should be deleted. The remarks with regard to claims 1-3 and 5-11 and 13-14 also apply to similar language in claims 15-17 and 19-25. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. Claims 7 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 7 and 21, is Applicant claiming the range of at least about 20 percent to 100 percent or the range of at least about 20 percent to no more than about 50 percent?

***Claim Language Interpretation***

9. "Labial" or "interlabial" devices or pads are defined as set forth on page 2, lines 19-22 and page 9, lines 6-8. It is noted however that the claims claim an absorbent article, see page 9, line 4. "Vestibule" is defined as set forth on page 9, lines 9-12, 16-18 and 22-24. Direction terms are defined as set forth on page 9, line 33-page 10, line 13. "Resilient extensibility" is

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defined as set forth on page 19, lines 14-18. "Primarily" and "partially" have not been specifically described in the specification and therefore are given their common, i.e. dictionary definition, i.e. "primarily" is defined as "chiefly; principally", i.e. more than 50%, and "partially" is defined as "of, pertaining to, or affecting only part; not total", i.e. 0% to less than 100%. "Printed" also has not been specifically described and therefore will be given its common definition, i.e. "a mark or impression made in or on a surface by pressure".

### ***Effective Filing Dates of Claims***

10. The effective filing date of claims 1, 5-11, 13, 15 and 19-25 is 12-13-96. The effective filing date of claims 2-3, 14 and 16-17 is the actual filing date of the instant application which is 12-31-01.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 2-3, 14 and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Edens et al '771.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

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102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 2-3 and 16-17: See Effective Filing Dates of Claims Section supra, Figures 19 and 22, paragraphs 39, 41, 66 and 67, i.e. the cover is 62, the baffle is 64, the absorbent is 66 and the flap is 86 or 106.

Claim 14: See definition of "printed" supra. Also see paragraph 67, i.e. the flap can be an extension of the baffle, paragraph 51, i.e. microembossed which is considered "printed indicia", of '771. It is noted that the claim does not define what the printed indicia indicates.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-3, 5-7, 11, 13, 15-17, 19-21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molnlycke PCT '008 in view of Lassen et al '062.

Claims 1, 5, 11, 13: See Claim Language Interpretation section supra, abstract, page 2, lines 4-28, page 3, lines 1-30, page 4, lines 5-17, page 5, line 36-page 6, line 3, claims 1-2 and Figures of PCT '008, i.e. the cover is 2, the baffle is 3, the absorbent is 1, the retainer flap as set forth on lines 5-6 and 10 et seq is elastic sheet 4 (It is noted that "elastic" as defined by the

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American Heritage Dictionary is "returning or capable of returning to an initial form or state after deformation"). Therefore the '008 device includes all the claimed structure except for the absorbent article being configured for disposition primarily with a vestibule of a female wearer. However, in the portions cited above, '008 sets forth that the retainer flap 4 constitutes an addition to any conventional sanitary towel, i.e. napkin, and that such avoids the necessity of having a separate receptacle, i.e. package. Furthermore see Lassen et al. '062 at, e.g., Figures 1, 2, 5-9 and 11 -16 as well as col. 1, lines 14-27 and 30-32, col. 5, lines 63-68, col. 6, line 17-22, col. 9, lines 20-63, col. 19, line 39-col. 20, line 6, i.e. conventional absorbent articles include sanitary napkins which are configured for partial, i.e. less than 100%(includes more than 50% and thus "primarily"), disposition with in the vestibule of a female wearer which are packaged in a separate receptacle. Therefore to employ a conventional sanitary napkin, such as that taught by Lassen et al., which is configured for disposition primarily within the vestibule of a female wearer and is packaged in a separate receptacle on the '008 device would be obvious to one of ordinary skill in the art in view of the recognition that such a configured sanitary napkin is conventional and such combination would obviate the need for a separate receptacle, i.e. cost and use efficient, and the desire of '008 to be combined with any conventional sanitary napkin and obviate the need for a separate package.

Claims 2-3: Note that '008 teaches the flap extends parallel to the axis of fold along which the article is folded. Since the Lassen napkin can be folded along the transverse or longitudinal axis, see Figures 13-16 and Figures 11-12, the combination of the napkin of Figures 11-12 and '008, i.e. the retainer flap, see discussion of claim 1 supra, would include a

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combination in which the flap is configured as claimed in claims 2-3 and 16-17, i.e. longitudinally.

Claims 6-7: see Figures 1-2, i.e. at least about 15%, and Figures 3-5, i.e. about 50%.

Claims 15, 19-21 and 25: see discussion of claims 1, 5-7, 11 and 13 supra.

15. Claims 8-10 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molnlycke '008 and Lassen et al '062 as applied to claims 1 and 15 above, and further in view of Lenaghan '326 and Srinivasan '567.

Claims 8, 10, 22 and 24: The PCT '008 reference teaches folding the flap first and then folding the napkin whereas the claims require that the flap be adapted to be folded over the opposing portions, i.e. the capability of folding the napkin first and then the flap which '008 does not necessarily teach. However see Lenaghan, Figures, and Srinivasan at Figures 7-11. To fold the napkin first and then fold the pocket material as taught by Lenaghan and Srinivasan on the PCT '008 device would have been obvious to one of ordinary skill in the art in view of recognition that such would better prevent the contents and soiled surfaces from contacting the exterior, i.e. by folding first, the contents and surfaces would first be shielded prior to any other manipulation, and the desire of PCT '008 to so shield.

Claims 9 and 23: see definitions of "elastic" and "resiliently extensible" supra and the portions of '008 cited supra, e.g. abstract, lines 7 and 11-15, i.e. the flap would necessarily and inevitably actively retract as claimed.

### ***Double Patenting***

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 1, 5-11, 13, 15 and 19-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 35-64 of copending Application No. 09/975,108(2002/0013566). Although the conflicting claims are not identical, they are not patentably distinct from each other because since the effective filing dates of the two applications are the same, the one way *In re Vogel* test applies, i.e. are the claims of the instant invention obvious in view of the claims of the '108 application. The answer is yes. The claims of the instant application are broader than the '108 claims, e.g. they do not require placement at one end or adhesive. However once the applicant has received a patent for a species of more specific embodiment, i.e. if application '108 were to be issued, the applicant is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Common Ownership***

18. Claims 1, 5-11, 13, 15 and 19-25 are directed to an invention not patentably distinct from claims 35-64 of commonly assigned application 09/975,108(2002/0013566). Specifically, see discussion in paragraph 17~~7~~supra.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 09/975,108, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

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*Conclusion*

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited shows various absorbent articles in combination with printed indicia or packaging.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
October 31, 2003